

## REMARKS

Receipt of the Office action dated January 13, 2004, is acknowledged. Claims 1-13, 36-46 and 51-57 are pending in the present application. The drawings have been objected to as failing to comply with 37 CFR 1.83(a). In keeping with the foregoing amendments and the following arguments, allowance of the rejected claims and the new claims submitted with this response is respectfully requested.

The drawings have been objected to as failing to comply with 37 CFR 1.83(a). In particular, the Office action states that "means for removably fastening" as recited in claim 7 is not shown in the drawings. Claim 7 has been cancelled, and therefore, the objection should be withdrawn.

### **Claim Rejections under 35 U.S.C. § 102(b)**

Claims 1-3, 6, 9-13, 36, 37, 40 and 41 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fried et al., U.S. Patent 4,938,439 (Fried). Of the claims that have been rejected under §102(b) over Fried, claims 1 and 36 are independent.

Claim 1 has been amended to recite that the body support device comprises an underside portion having a plurality of substantially right angled steps, each step adapted to contact an edge portion of a counter when the step is placed on the counter. In contrast Fried does not disclose a plurality of right angled steps as recited in claim 1.

Fried discloses an automobile armrest/tray accessory that includes a double wedge-shaped resilient body 14 having a rigid backing 12. Referring to FIG. 2, a narrow wedge 10a of the resilient body 14 can be forcibly inserted in a gap between a seat and a center console of an automobile so that a passenger can rest his arm on a top

surface 18 of the resilient body 14. Referring to FIG. 3, the resilient body 14 can alternately be placed on a person's lap so that the rigid backing 10 functions as a tray.

Applicants submit that Fried does not disclose an underside portion having plurality of substantially right angled steps. Referring to FIGS. 2 and 3, in which two operative orientations of Fried are illustrated, parts of Fried that can be considered an underside portion in both orientations never include more than three surfaces. For example, in FIG. 2, surfaces 10a, 20 and 14 can be considered part of an underside portion, while surfaces 10b, 18 and 16 cannot be considered underside portions because they are not on an underside of the Fried device. In FIG. 3, surfaces 10b, 14 and 20 can be considered part of an underside portion, while surfaces 10a, 16 and 18 cannot be considered part of an underside portion because they are not on an underside of the Fried device. Therefore, surfaces 10a and 10b cannot be simultaneously considered together as part of an underside portion of Fried because they are not simultaneously oriented on an underside of the Fried device in both configurations of the Fried device.

A step is defined in *Merriam-Webster Dictionary* as a combination of a "riser" and the "tread." Accordingly, at least four surfaces consisting of two pairs of riser/tread combinations are required for a pair of steps. However, as described in the foregoing, Fried does not disclose more than three surfaces on an underside thereof in any of its operative orientations. Therefore, applicants submit the Fried does not disclose a plurality of steps. Furthermore, Fried does not disclose a plurality of substantially right angled steps. As shown in FIG. 1 of Fried, the surface 14 forms an angle with each of the surfaces 20 and 10b that is substantially greater than a near right angle or near 90 degrees.

Because an underside portion having a plurality of substantially right angled steps is not disclosed in Fried, Fried does not disclose every element of claim 1.

Therefore, claim 1 is patentable over Fried and rejection of claim 1, and claims 2-6 and 2-13 depending therefrom should be withdrawn.

Claim 36 has been amended to recite a method for supporting the body of a person when leaning over a counter that comprises, in part, placing a removable body support device on an edge portion of the counter, and leaning on the body support device by a frontal hip and abdominal region of the person, the leaning causing a substantial lateral portion of the frontal hip and abdominal region of the person to press against the upper side of the body support device. In contrast, Fried does not disclose or even suggest the noted elements of claim 36.

Referring to FIG. 2, the device of Fried is wedged between a seat and a center console of an automobile. In this orientation, a user can rest his elbow on the surface 18. Referring to FIG. 3, the device of Fried is placed on a person's lap so that the rigid surface 10 can be used as a tray. Accordingly, both operative orientations of the Fried device neither disclose nor even suggest placing a removable body support device on an edge portion of the counter, and leaning on the body support device by a frontal hip and abdominal region of the person, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side of the body support device.

Because placing a removable body support device on an edge portion of the counter, and leaning on the body support device by a frontal hip and abdominal region of the person, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side of the body support device, is not

disclosed in Fried, Fried does not disclose every element of claim 36. Therefore, claim 36 is patentable over Fried and rejection of claim 36, and claims 37-41 depending therefrom should be withdrawn.

**Claim Rejections under 35 U.S.C. § 103(a)**

Claims 4, 5, 38, 44-46, 51 and 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fried in view of Kobayashi, et al., Japanese Patent 11206537(Kobayashi).

Regarding the rejection of claims 4, 5 and 38, a proper obviousness rejection requires that the cited prior art teach or suggest all of the limitations of the rejected claims. Claims 4 and 5 depend from claim 1, and claim 38 depends from claim 36. Accordingly, in view of the amendments to base claims 1 and 36, dependent claims 4, 5 and 38, respectively, include the same limitations discussed above. Therefore, because the above noted claim limitations are clearly missing from the Fried/Kobayashi combination, the rejection of dependent claims 4, 5 and 38 should be withdrawn. *See In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

Claim 44 has been amended to now partly recite, in part, placing a weight on a portion of the body support device disposed on top of the elevated surface, the placing of the weight causing the body support device to remain on the edge portion of the counter, and leaning on the body support device with a frontal hip and abdominal region of a person, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the body support device. In contrast, each of Kobayashi, Fried, or a combination thereof does not disclose or suggest the noted element of claim 1.

There is no teaching, suggestion, or motivation in any one of Fried or Kobayashi to provide the steps of placing of the weight causing the body support device to remain on the edge portion of the counter, and leaning on the body support device with a frontal hip and abdominal region of a person, the leaning causing a substantial lateral portion of the frontal hip and abdominal region of the person to press against the body support device. Absent such teaching, suggestion, or motivation in either each of the references or the combination thereof, a *prima facie* case of obviousness cannot be established. *ACS Hospital Systems, Inc. v. Monteforre Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

As described in detail in the foregoing, Fried does not disclose or even suggest placing a weight on the armrest/tray device. On the other hand, Kobayashi discloses a therapeutic pillow that includes a plurality of magnets therein for providing a magnet treatment effect. However, Kobayashi does not disclose or even suggest the steps of placing of the weight on the body support device to cause the body support device to remain on the edge portion of the counter, and leaning on the body support device with a frontal hip and abdominal region of a person, the leaning causing a substantial lateral portion of the frontal hip and abdominal region of the person to press against the body support device.

Furthermore, modifying Kobayashi's magnets to serve as weights would destroy the intended function of Kobayashi. Kobayashi's magnets 7 are distributed on the surface of the pillow of Kobayashi and can contact a person's head when on the pillow. Accordingly, the magnets 7 of Kobayashi are most likely very small, thin, and light weight. If the magnets 7 were sized to serve as weights for the pillow of Kobayashi, they would prevent a person from easily moving the pillow, would be uncomfortable as

each magnet could contact the person's head when on the pillow, and could not be securely distributed on the surface of the pillow. Accordingly, for the foregoing reasons, one of ordinary skill in the art could not have taken any of Fried and Kobayashi, or a combination thereof, to provide the method of supporting the body of a person as recited in claim 44. Therefore, claim 44, and claims 45, 46, 51 and 52 depending therefrom, are patentable over Fried in view of Kobayashi.

Claims 8, 42 and 43 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fried in view of Klemis, U.S. Patent 5,199,124 (Klemis). Regarding the rejection of claim 8, a proper obviousness rejection requires that the cited prior art teach or suggest all of the limitations of the rejected claims. Claim 8 depends from claim 1. Accordingly, in view of the amendments to base claim 1, dependent claim 8 includes the same limitations discussed above. Therefore, because the above noted claim limitations are clearly missing from the combination of Fried and Klemis, the rejection of dependent claim 8 should be withdrawn.

Claim 42 has been amended to recite a method for supporting the body of a person when leaning over a counter comprising, in part, leaning on the outer side of the body support device when leaning over the counter, the leaning causing a substantial lateral portion of the frontal hip and abdominal region of the person to press against the upper side. In contrast, any one of Fried and Klemis, or a combination thereof, does not disclose or suggest the noted step of claim 42.

There is no teaching, suggestion, or motivation in any one of Fried or Klemis to provide the steps of leaning on the outer side of the body support device when leaning over the counter, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side. Absent such teaching,

suggestion, or motivation in either each of the references or the combination thereof, a prima facie case of obviousness cannot be established. *ACS Hospital Systems, Inc. v. Monteforre Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

As described in detail in the foregoing, Fried does not disclose or even suggest the steps of leaning on the outer side of the body support device when leaning over the counter, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side. Additionally, Klemis does not disclose or even suggest leaning on the outer side of the body support device when leaning over the counter, the leaning causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side.

Additionally, applicants submit that Klemis could not be modified to provide the step of causing a substantial portion of the frontal hip and abdominal region of the person to press against the upper side of the body support device, because such a modification would destroy the intended function of Klemis.

Klemis provides a cushion 10 that is fastened to a person and is oriented vertically so as to prevent a person from rolling on his stomach while asleep. As shown in FIGS. 2 and 3 of Klemis, the cushion 10 is narrow and extends vertically along the torso of a person. As shown in FIG. 5, this orientation of the cushion 10 allows the person using the cushion 10 to roll on his side while asleep. Accordingly, if the cushion 10 of Klemis is modified to cause a substantial lateral portion of the frontal hip and abdominal region of the person to press against the upper side, the person using the cushion of Klemis could not roll onto his sides while asleep. Accordingly, such modification of Klemis would destroy the function shown in FIG. 5. Accordingly, one of ordinary skill in the art could not have taken any one of Fried and Klemis, or a


combination thereof, to provide the method of supporting the body of a person as recited in claim 42. Therefore, claim 42, and claim 43 depending therefrom, are patentable over Fried in view of Klemis.

Claims 53-57 have been cancelled and the rejection thereof is now moot.

Claim 52 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Fried in view of Kobayashi and further in view of Klemis. In view of the amendment to independent claim 44 and the arguments present above, claim 52 is now patentable and the rejection thereof should be withdrawn.

In view of the foregoing the above-identified application is in condition for allowance. In the event there is any remaining issue that the Examiner believes can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned attorney at (312) 474-6639.

Respectfully submitted,



Saeid Mirsafian  
Reg. No. 52,035  
MARSHALL, GERSTEIN & BORUN  
233 S. Wacker Dr.  
6300 Sears Tower  
Chicago, Illinois 60606  
(312) 474-6300

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